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Paper No.

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MAILED

FEB 02 2009

OFFICE OF PETITIONS

In re Application of	:	
Nai-Kong V. Cheung	:	DECISION ON
Application No. 10/621,027	:	APPLICATION FOR
Filed: 07/16/2003	:	PATENT TERM ADJUSTMENT
Attorney Docket No.	:	
#639-B-PCT-US	:	

This is in response to the APPLICATION FOR PATENT TERM ADJUSTMENT filed on November 25, 2008. Applicant requests that the determination of patent term adjustment be increased from zero (0) days to two hundred fifty-four (254) days. Applicant requests this correction on the basis that the Office will take in excess of three years to issue this patent and in light of the recent court decision in Wyeth v. Dudas, No. 07-1492 (D.D.C. September 30, 2008).

To the extent that the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, a decision is being **held in abeyance** until after the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.703(b).

Applicant is given TWO (2) MONTHS from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within 3 years. A copy of this decision should accompany the request. Applicant may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of § 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

Rather than file the request for reconsideration of Patent Term Adjustment at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term pursuant to 37 CFR 1.705(d). The USPTO notes that it does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent and accordingly, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent.

To the extent that applicant requests review of the patent term adjustment at the time of the mailing of the notice of allowance, the request for review is granted.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance remains zero (0) days, including entry of additional periods of reduction of 41 and 109 days for applicant delay. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

A review of the record reveals additional bases for entry of periods of reduction for applicant delay. Specifically, 37 CFR 1.704(c), states, in pertinent part, that

Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment

set forth in § 1.703 to the extent that the periods are not overlapping:

(8) Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed.

(10) Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

(i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper; or (ii) Four months.

37 CFR 1.704(d) states:

A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement.

On December 17, 2007, an Information Disclosure Statement (IDS) was filed, 41 days after the filing of an amendment on November 6, 2007. The IDS did not contain the statement set forth in 37 CFR 1.704(d). Accordingly, pursuant to 37 CFR 1.704(c)(8), an

additional reduction of 41 days of patent term adjustment is being entered.

After the mailing of the notice of allowance on January 24, 2008 (and after the payment of the issue fee on April 2, 2008), on June 6, 2008, applicant filed a Petition to Withdraw from Issue, a Request for Continued Examination (RCE) and an Information Disclosure Statement (IDS). The IDS did not contain the statement set forth in 37 CFR 1.704(d). In response, the Office mailed a decision on petition to withdraw from issue on June 11, 2008 and a notice of allowance on September 22, 2008. Accordingly, pursuant to 37 CFR 1.704(c)(10), an additional reduction of 109 days of patent term adjustment is being entered (for the period beginning on June 6, 2008 and ending on September 22, 2008 (which totally overlaps with the period beginning on June 6, 2008 and ending on June 11, 2008)).

In view thereof, the correct patent term adjustment at the time of mailing of the notice of allowance is zero (0) days.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this matter should be directed to Senior Petitions Attorney Douglas I. Wood at (571) 272-3231.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of revised PALM Screen

PALM INTRANET

Day : Monday
Date: 2/2/2009
Time: 10:30:15

PTA Calculations for Application: 10/621027

Application Filing Date:	07/16/2003	PTO Delay (PTO):	92
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	304
Post-Issue Petitions:	0	Total PTA (days):	0
PTO Delay Adjustment:	-150		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
143	02/02/2009	ADJUSTMENT OF PTA CALCULATION BY PTO		41	
142	02/02/2009	ADJUSTMENT OF PTA CALCULATION BY PTO		109	
132	09/22/2008	MAIL NOTICE OF ALLOWANCE			
131	08/14/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
130	08/14/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
129	08/14/2008	ISSUE REVISION COMPLETED			
128	08/14/2008	DOCUMENT VERIFICATION			
127	08/14/2008	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
126	08/14/2008	EXAMINER'S AMENDMENT COMMUNICATION			
125	08/14/2008	NOTICE OF ALLOWABILITY			
122	06/06/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
121	06/06/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
120	06/17/2008	DATE FORWARDED TO EXAMINER			
119	06/06/2008	REQUEST FOR CONTINUED EXAMINATION (RCE)			
118	06/17/2008	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
117	06/11/2008	MAIL-RECORD PETITION DECISION OF GRANTED TO WITHDRAW FROM ISSUE			
116	06/11/2008	RECORD PETITION DECISION OF GRANTED TO WITHDRAW FROM ISSUE			
115	06/06/2008	PETITION ENTERED			
114	06/06/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			

113	06/06/2008	WORKFLOW - REQUEST FOR RCE - BEGIN			
112	05/06/2008	TC RETURN TO PUBS			
111	04/02/2008	ISSUE FEE PAYMENT VERIFIED			
110	04/02/2008	ISSUE FEE PAYMENT RECEIVED			
109	02/08/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
108	02/08/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
107	02/26/2008	PUBS CASE REMAND TO TC			
106	03/11/2008	WORKFLOW - QUERY REQUEST - BEGIN			
105	02/08/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
104	02/08/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
103	01/29/2008	EXPORT TO INITIAL DATA CAPTURE			
102	01/24/2008	MAIL NOTICE OF ALLOWANCE			
102	01/24/2008	MAIL NOTICE OF ALLOWANCE			
101	01/24/2008	MAIL EXAMINER'S AMENDMENT			
101	01/24/2008	MAIL EXAMINER'S AMENDMENT			
100	01/22/2008	DOCUMENT VERIFICATION			
100	01/22/2008	DOCUMENT VERIFICATION			
99	01/22/2008	ISSUE REVISION COMPLETED			
99	01/22/2008	ISSUE REVISION COMPLETED			
98	01/22/2008	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
97	01/22/2008	CASE DOCKETED TO EXAMINER IN GAU			
96	01/22/2008	EXAMINER'S AMENDMENT COMMUNICATION			
95	01/22/2008	NOTICE OF ALLOWABILITY			
94	12/17/2007	REFERENCE CAPTURE ON IDS			
93	12/17/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
92	12/17/2007	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
90	12/17/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
89	10/26/2007	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
86	11/14/2007	DATE FORWARDED TO EXAMINER			
85	11/06/2007	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			

84	10/26/2007	REFERENCE CAPTURE ON IDS			
83	10/26/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
82	11/14/2007	DATE FORWARDED TO EXAMINER			
81	10/26/2007	REQUEST FOR CONTINUED EXAMINATION (RCE)			
80	11/14/2007	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
79	10/26/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
78	10/26/2007	WORKFLOW - REQUEST FOR RCE - BEGIN			
77	08/07/2007	MAIL FINAL REJECTION (PTOL - 326)			
76	08/06/2007	FINAL REJECTION			
74	06/04/2007	AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED			
73	06/07/2007	DATE FORWARDED TO EXAMINER			
72	06/04/2007	RESPONSE AFTER NON-FINAL ACTION		61	65
71	06/04/2007	REQUEST FOR EXTENSION OF TIME - GRANTED			
70	07/16/2003	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
69	07/16/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
68	01/31/2007	MAIL MISCELLANEOUS COMMUNICATION TO APPLICANT			
67	01/29/2007	MISCELLANEOUS COMMUNICATION TO APPLICANT - NO ACTION COUNT			
66	01/22/2007	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
65	01/04/2007	MAIL NON-FINAL REJECTION			
64	12/21/2006	NON-FINAL REJECTION			
63	12/20/2006	CASE DOCKETED TO EXAMINER IN GAU			
62	09/14/2006	DATE FORWARDED TO EXAMINER			
61	09/07/2006	RESPONSE AFTER NON-FINAL ACTION		93	59
60	09/07/2006	REQUEST FOR EXTENSION OF TIME - GRANTED			
59	03/06/2006	MAIL NON-FINAL REJECTION			
58	03/03/2006	NON-FINAL REJECTION			
57	01/11/2006	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
		INFORMATION DISCLOSURE STATEMENT			

56	01/11/2006	CONSIDERED			
55	02/07/2006	CASE DOCKETED TO EXAMINER IN GAU			
54.7	01/11/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		30	49
54	01/11/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
53.7	01/11/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
53	01/11/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
52	01/04/2006	DATE FORWARDED TO EXAMINER			
51	12/12/2005	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
50	01/04/2006	DATE FORWARDED TO EXAMINER			
49	12/12/2005	REQUEST FOR CONTINUED EXAMINATION (RCE)		60	41
48	01/04/2006	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
47	12/12/2005	REQUEST FOR EXTENSION OF TIME - GRANTED			
46	12/12/2005	WORKFLOW - REQUEST FOR RCE - BEGIN			
45	10/04/2005	MAIL ADVISORY ACTION (PTOL - 303)			
44	10/03/2005	ADVISORY ACTION (PTOL-303)			
43	09/19/2005	DATE FORWARDED TO EXAMINER			
42	09/13/2005	AMENDMENT AFTER FINAL REJECTION			
41	07/13/2005	MAIL FINAL REJECTION (PTOL - 326)			
40	07/11/2005	FINAL REJECTION			
39	06/15/2005	MISCELLANEOUS INCOMING LETTER			
38	05/20/2005	MISCELLANEOUS INCOMING LETTER			
37	05/16/2005	REFERENCE CAPTURE ON IDS			
36.7	05/16/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		46	33
36	05/16/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
35.7	04/28/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
35	04/28/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
34	04/27/2005	DATE FORWARDED TO EXAMINER			
33	03/31/2005	RESPONSE AFTER NON-FINAL ACTION		14	27

32	03/31/2005	REQUEST FOR EXTENSION OF TIME - GRANTED			
31	04/12/2005	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
30.7	03/29/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
30	03/29/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
29	11/24/2004	REFERENCE CAPTURE ON IDS			
28.7	11/24/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
28	11/24/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
27	12/17/2004	MAIL NON-FINAL REJECTION	92		-1
26.7	11/12/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
26	11/12/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
25	11/10/2004	NON-FINAL REJECTION			
24.7	09/27/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
24	09/27/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
23	10/15/2004	CASE DOCKETED TO EXAMINER IN GAU			
22.7	07/14/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
22	07/14/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
21	05/28/2004	PRELIMINARY AMENDMENT			
20	02/20/2004	OATH OR DECLARATION FILED (INCLUDING SUPPLEMENTAL)			
19	07/17/2003	REFERENCE CAPTURE ON IDS			
17	07/17/2003	NEW OR ADDITIONAL DRAWING FILED			
16	07/17/2003	PRELIMINARY AMENDMENT			
15	05/28/2004	WORKFLOW INCOMING AMENDMENT IFW			
14	03/08/2004	APPLICATION RETURN FROM OIPE			
13	03/08/2004	APPLICATION RETURN TO OIPE			
12	03/08/2004	APPLICATION DISPATCHED FROM OIPE			
11	03/08/2004	APPLICATION IS NOW COMPLETE			
10	01/16/2004	ADDITIONAL APPLICATION FILING FEES			
		A STATEMENT BY ONE OR MORE INVENTORS			

9	01/16/2004	SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC			
8	12/15/2003	PRE-EXAM OFFICE ACTION WITHDRAWN			
7	12/15/2003	NOTICE MAILED--APPLICATION INCOMPLETE-- FILING DATE ASSIGNED			
4	10/07/2003	CASE CLASSIFIED BY OIPE			
3	10/07/2003	CLEARED BY OIPE CSR			
2	09/07/2003	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	07/17/2003	INITIAL EXAM TEAM NN			

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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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